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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM JOSEPH EAKIN

Appeal 2007-3230
Application 10/685,366¹
Technology Center 2600

Decided: October 21, 2008

Before KENNETH W. HAIRSTON, MAHSHID D. SAADAT, and
SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

¹ Application filed October 14, 2003. The real party in interest is
Hewlett-Packard Development Company, L.P.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-6, 12-17, and 19-32.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellant's invention relates to "a system and method for remotely accessing a private database using a wireless communication device."

(Spec. paragraph [1].)

Claim 1 is exemplary:

1. A method for communicating information from a private database to a wireless communication device, the method comprising:

receiving a private database access request from the wireless communication device, the private database access request including at least an appliance identification (ID) that uniquely identifies the wireless communication device;

comparing the appliance ID with a security indicia, the security indicia associated with the wireless communication device; and

communicating the information from the private database to the wireless communication device when the appliance ID corresponds to the security indicia, wherein verification of only the appliance ID is sufficient to authorize access to the private database.

(Claims App., App. Br. 28)

² Claims 7-11 and 18 have been indicated to be allowable if rewritten in independent form. (Ans. 2.)

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Wilber	US 5,333,152	Jul. 26, 1994
Ronen	US 5,745,556	Apr. 28, 1998
Schneider et al.	US 6,178,505 B1	Jan. 23, 2001
Yamazaki	US 6,297,726 B1	Oct. 2, 2001
Rezvani et al.	US 2002/0077077 A1	Jun. 20, 2002
Garrison	US 2002/0069355 A1	Jun. 6, 2002
Khoury et al.	US 6,665,396 B1	Dec. 16, 2003 (filed Oct. 6, 2000)
Shimada	US 6,763,091 B2	Jul. 13, 2004 (filed Sep. 20, 2002)
Obuchi et al.	US 6,789,093 B2	Sep. 7, 2004 (filed Mar. 20, 2001)

Claims 1-6, 12-17, and 19-31 stand rejected under 35 U.S.C. § 103(a) as being obvious over Garrison, Rezvani, and one of (Shimada, Wilber, Khouri, Obuchi, Ronen, or Yamazaki).

Claim 32 stands rejected under 35 U.S.C. § 103(a) as being obvious over Garrison, Rezvani, one of (Shimada, Wilber, Khouri, Obuchi, Ronen, or Yamazaki), and Schneider.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments that Appellant did not make in the Briefs have not

been considered and are deemed to be waived. *See* 37 C.F.R.

§ 41.37(c)(1)(vii).³

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a).

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. Garrison describes a system that allows remote access to a database using a wireless communication device. (Abstract; paragraphs [0003], [0033], [0042]; Figs. 1, 4A, 4B) When remote access to a database is permitted, Garrison teaches that there is a risk that a hacker could break into the database system. (Paragraph [0011]) Garrison describes an authentication process using an encrypted log name and password to provide more secure access to the database system. (Paragraphs [0012], [0013], [0039] through [0043])
2. Rezvani describes a system and method for communicating with a wireless communication device that includes a discovery mode and an

³ Except as will be noted in this opinion, Appellant has not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

- operating mode. (Abstract; Paragraphs [0002], [0004] through [0007], [0012], [0018], [0055]) Wireless communications devices are registered in the discovery mode, and communications from registered devices are received in the operating mode. (*Id.*)
3. Rezvani teaches that "[c]ellular telephones work on the principle that each specific instance of a telephone handset is different, and the exact identification of particular instances of a cellular telephone is critical." (Paragraph [0004]) "A cellular provider only wants individuals registered with their services and in good standing to use their networks." (*Id.*) Thus, Rezvani teaches that "[t]he electronic subscriber number, or ESN, is used at registration time to identify cellular phones within the system." (*Id.*) "Each time a call is placed, the ESN serves as the authentication token to gain access to the network." (*Id.*) "The ESN is stored on the service provider's system and compared against the one sent by the phone when a call is made or when heartbeat event occurs." (*Id.*) "Such a system creates an ownership and privilege relationship between the phone and the service provider." (Paragraph [0005])
 4. Rezvani teaches that a user may remotely access a database using the wireless communication device. (Paragraphs [0108] to [0111], [0113], [0117] through [0121]; Fig. 9)
 5. For example, referring to Fig. 9, Rezvani teaches "[s]ystem 10 provides users with opportunities to remotely control and monitor

devices 32 using remote user access devices 17 via communications network 16." (Paragraph [0118]) Remote user access devices 17 include cellular telephones. (Paragraph [0113]) "In practice, a suitable system architecture and communications network 16 may allow users . . . to readily monitor and control monitoring modules 28 from any location using any suitable device that is capable of communicating with remote site 14 via communications network 16." (Paragraph [0118].) Rezvani describes an example in which a camera 34 takes a picture of a front door when contact sensor 40 is tripped. (Paragraph [0121]) The picture is transmitted over communications network 16 and stored in database server 48. (*Id.*) The user is notified and may "access the picture using web server 46 of remote site 14 via Internet browser 26." (*Id.*) Rezvani also teaches that "users may access the system shown in system 10 via any computer, monitoring module, or *remote user access device* [17] linked to communications network 16." (Paragraph [0113] (emphasis added))

6. Shimada describes using the telephone number of a device to register the device and connect to a network. (Abstract; Fig. 1)

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the Applicant to rebut. *Id.*; see also *In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the Applicant produces rebuttal evidence of adequate weight, the *prima facie* case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is the Appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [for obviousness] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). In *KSR*, the Supreme Court reaffirmed that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739. The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of

ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The Court also explained that:

[o]ften, it will be necessary. . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 1740-41.

"[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d at 988. "To facilitate review, this analysis should be made explicit." *KSR*, 127 S. Ct. at 1741. However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ."

Id.

The Supreme Court noted that "[u]nder the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742. The Court also noted that "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able

to fit the teachings of multiple patents together like pieces of a puzzle." *Id.*
"A person of ordinary skill is also a person of ordinary creativity, not an
automaton." *Id.*

In sustaining a multiple reference rejection under 35 U.S.C. § 103(a),
the Board may rely on one reference alone without designating it as a new
ground of rejection. *In re Bush*, 296 F.2d 491, 496 (CCPA 1961); *In re*
Boyer, 363 F.2d 455, 458 n.2 (CCPA 1966).

During examination of a patent application, a claim is given its
broadest reasonable construction consistent with the specification. *In re*
Prater, 415 F.2d 1393, 1404-05 (CCPA 1969). "[T]he words of a claim 'are
generally given their ordinary and customary meaning.'" *Phillips v. AWH*
Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal citations
omitted). The "ordinary and customary meaning of a claim term is the
meaning that the term would have to a person of ordinary skill in the art in
question at the time of the invention, i.e., as of the effective filing date of the
patent application." *Id.* at 1313.

ANALYSIS

Appellant contends that the Examiner erred in rejecting claims 1-6,
12-17, and 19-32. Reviewing the record before us and the findings of facts
cited above, we do not agree. In particular, we find that Appellant has not
shown that the Examiner failed to make a prima facie showing of
obviousness with respect to claims 1-6, 12-17, and 19-31 and with respect to
claim 32. Appellant failed to meet the burden of overcoming these prima
facie showings.

I. Claims 1-6, 12-17, and 19-31

Initially, Appellant argues that there is no teaching or suggestion to combine the teachings of Garrison and Rezvani and that the Examiner used impermissible hindsight. (App. Br. 11-13) We do not agree.

The Examiner found that one of ordinary skill in the art would have been motivated to combine the teachings of Garrison and Rezvani in order to uniquely identify the cellular device using the ESN before a connection to a remote database is allowed. (Ans. 6, 18) Appellant has not shown error in the Examiner's articulated rationale, has not presented any convincing evidence to demonstrate a teaching away or lack of a reasonable expectation of success, and has not shown any improper hindsight used by the Examiner. In addition, we note that the claim limitations identified by the Examiner as being taught or suggested by Garrison also are taught or suggested by Rezvani. (Ans. 4-5, 16; FF 3-5) Thus, the teachings of Garrison are cumulative to those of Rezvani and further buttress the conclusion of obviousness.

Independent claims 1, 12, 19, 22, 24, 25, and 27:

Next, regarding independent claims 1, 12, 19, 22, 24, 25, and 27, Appellant argues that Garrison and Rezvani do not teach or suggest "wherein verification of only the appliance ID is sufficient to authorize access to the private database," as recited in claim 1 and similarly recited in the other independent claims. (App. Br. 14-15; Reply Br. 2-5) We do not agree.

As the Examiner correctly found, Rezvani teaches this limitation by teaching both access to a remote database using a wireless communication

device and use of only the ESN of the wireless communication device for authentication. (Ans. 5, 16, 18; FF 3-5) By teaching that each time a call is placed, the "ESN serves as the authentication token to gain access to the network" (FF 3), Rezvani suggests using only the ESN (ID) to authenticate when granting access to the remote database. Rezvani does not teach or suggest using any additional security measures beyond the ESN in order to conduct the authentication.

As noted *supra*, Rezvani alone teaches or suggests all limitations of independent claims 1, 12, 19, 22, 24, 25, and 27. The teachings of Garrison are cumulative to those of Rezvani and further buttress the conclusion of obviousness. In addition, combining Rezvani with Garrison does not teach away from using only the ESN to authenticate. Garrison teaches that additional security measures may be desired in the authentication process due to the threat of hackers breaking into the system. (FF 1) However, this does not teach away from using only the ESN, especially in situations where the risk of not using additional security measures is deemed acceptable.

Claims 1 and 12:

Appellant has argued claims 1 and 12 together as a group. (App. Br. 16-18) Thus, in accordance with 37 C.F.R. § 41.37(c)(1)(vii), we select claim 1 as representative.

Appellant argues that Garrison and Rezvani do not teach or suggest a "private database access request including at least an appliance identification (ID) that uniquely identifies the wireless communication device." (App. Br. 16-18) We do not agree.

Similar to the discussion of claim 1 *supra*, Rezvani discloses this limitation by teaching both access to a remote database using a wireless communication device and use of the ESN of the wireless communication device for authentication. (Ans. 5, 16, 18; FF 3-5) By teaching that *each time* a call is placed, such as when a call is placed to request access to the private database, the "ESN serves as the authentication token to gain access to the network" (FF 3), Rezvani suggests including the ESN (ID) with the private database access request.

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a). Claim 12 was argued as a group with claim 1 (App. Br. 16-18), and falls together with claim 1. Dependent claims 2-6, 13, and 17 were not argued separately and fall together with independent claims 1 and 12, from which they depend.

Claims 19, 22, 24, 25:

Appellant has argued claims 19, 22, 24, and 25 together as a group. (App. Br. 18-20) Thus, in accordance with 37 C.F.R. § 41.37(c)(1)(vii), we select claim 19 as representative.

Appellant repeats some of the same arguments previously presented with respect to claim 1, and we disagree with those arguments for the reasons previously discussed. In addition, Appellant argues that Garrison and Rezvani do not teach or suggest "an appliance identification (ID) corresponding to a multiple-use identifier that is included in all transmitted RF communications from the wireless communication device," as claimed. (App. Br. 18-20) We do not agree.

As the Examiner correctly found, the ESN taught by Rezvani meets the limitation of an appliance ID corresponding to a "multiple-use identifier." (Ans. 6-7) The Specification teaches that a serial number or other unique identifier of a cell phone is a "multiple-use identifier" since it "uniquely identifies the appliance as an authorized device to embodiments of the private database wireless access system." (Spec. paragraph [28]) The ESN of Rezvani uniquely identifies a cellular phone as an authorized device to access the network (FF 3) and thus, under the broadest reasonable interpretation consistent with the Specification, is an appliance ID corresponding to a multiple-use identifier.

Similar to the discussion of claim 1 *supra*, Rezvani teaches that the multiple-use identifier is included in all transmitted RF communications from the wireless communication device by teaching the use of the ESN of the wireless communication device for authentication. (Ans. 5, 16, 18; FF 3-5) By teaching that *each time* a call is placed, the "ESN serves as the authentication token to gain access to the network" (FF 3), Rezvani suggests including the ESN (ID) in all transmitted RF communications.

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 19 under 35 U.S.C. § 103(a). Claims 22, 24, and 25 were argued as a group with claim 19, and fall together with claim 19. Dependent claims 20, 21, 23, and 26 were not argued separately and fall together with independent claims 19, 22, and 25, from which they depend.

Claim 27:

Regarding claim 27, Appellant argues that Garrison and Rezvani do not teach or suggest an access request that includes an identification of the remote database and an identification (ID) of the portable wireless communication device (PWCD). (App. Br. 20-23) We do not agree.

Similar to the discussion of claims 1 and 19 *supra*, Rezvani teaches this limitation by teaching both access to a remote database using a wireless communication device and teaching the use of the ESN of the wireless communication device for authentication. (Ans. 5, 16, 18; FF 3-5) By teaching that the "ESN serves as the authentication token to gain access to the network" (FF 3) *each time* a call is placed, such as when a call is placed to request access to the database, Rezvani suggests including the ESN (ID) with the access request. In addition, the teaching of access to a remote database suggests including the identification of the remote database in the access request to ensure the requested information is retrieved from the correct source.

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 27 under 35 U.S.C. § 103(a). Dependent claim 29 was not argued separately and falls together with independent claim 27, from which it depends.

Claim 14:

Regarding claim 14, Appellant argues that Rezvani does not teach or suggest "transmitting a phone number of the wireless communication device as the appliance ID," as claimed. (App. Br. 23) We do not agree.

The Examiner found (Ans. 7) that Rezvani teaches transmitting the ESN as the appliance ID and that the ESN reads on a phone number. We agree that, under the broadest reasonable interpretation, the ESN may be construed as a "phone number" because it uniquely identifies the wireless communication device. In addition, Shimada teaches a phone number as the appliance ID by teaching the use of a telephone number to register the associated device and connect to a network. (FF 6)

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 14 under 35 U.S.C. § 103(a).

Claim 15:

Regarding claim 15, Appellant argues that Garrison and Rezvani do not teach or suggest "accessing the private database based on the identification and authorization of the wireless communication device, not identification of a user of the wireless communication device," as claimed. (App. Br. 23-24) We do not agree.

Similar to the discussion of claim 1 *supra*, Rezvani teaches this limitation by teaching both access to a remote database using a wireless communication device and use of the ESN of the wireless communication device for authentication. (FF 3-5) When accessing the remote database, the ESN identifies the wireless device and is used as an authorization of the wireless device itself. (*Id.*) The ESN does not identify the user of the wireless device.

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 15 under 35 U.S.C. § 103(a).

Claim 16:

Regarding claim 16, Appellant argues that Garrison and Rezvani do not teach or suggest "granting access to the private database without requiring a user of the wireless communication device to enter a password," as claimed. (App. Br. 24.) We do not agree.

Similar to the discussion of claims 1 and 15 *supra*, Rezvani teaches this limitation by teaching both access to a remote database using a wireless communication device and use of the ESN of the wireless communication device for authentication. (FF 3-5) By teaching that each time a call is placed, the "ESN serves as the authentication token to gain access to the network" (FF 3), Rezvani teaches granting access without requiring the user of the wireless device to enter a password. Rezvani does not teach or suggest the use of any additional security measures beyond the ESN in order to conduct the authentication or to access the database. Thus, Rezvani suggests granting access to the remote database without requiring the user of the wireless device to enter a password.

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 16 under 35 U.S.C. § 103(a).

Claim 28:

Regarding claim 28, Appellant argues that Garrison does not teach two different forms of communication for transmitting information to the remote database. (App. Br. 24-25) We do not agree.

Claim 28 recites "transmitting, via both the internet and the RF communication, the information from the remote database to the PWCD." Although both Internet and RF transmissions are recited, the broadest

reasonable interpretation of the claim does not require parallel transmission using both the Internet and RF. Instead, the claim merely requires that both the Internet and RF are used at some point along the overall transmission path of the information from the remote database to the wireless device.

The Examiner found that Garrison teaches use of both Internet (wired) and RF (wireless) communications in the path from the remote database to the wireless device. (Ans. 11) In addition, Rezvani teaches that Internet and RF communications may be used in accessing a picture stored in database server 48 over communications network 16. (FF 5)

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 28 under 35 U.S.C. § 103(a).

Claims 30 and 31:

Appellant has argued claims 30 and 31 together as a group. (App. Br. 25) Thus, in accordance with 37 C.F.R. § 41.37(c)(1)(vii), we select claim 30 as representative.

Appellant argues that Garrison and Rezvani do not teach or suggest that the PWCD is a cellular phone and the ID is a cellular phone number of the cellular phone, as claimed. (App. Br. 25) We do not agree.

Similar to the discussion of claim 14 *supra*, Rezvani teaches that the PWCD may be a cellular phone and teaches transmitting the ESN as the appliance ID. (FF 3) Under the broadest reasonable interpretation, the ESN may be construed as a "cellular phone number of the cellular phone" because it uniquely identifies the cellular phone. In addition, Shimada teaches a phone number as the appliance ID by teaching the use of a telephone number to register the associated device and connect to a network. (FF 6)

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 30 under 35 U.S.C. § 103(a). Claim 31 was argued as a group with claim 30 and falls together with claim 30.

II. Claim 32

Appellant argues that the applied references do not teach or suggest authenticating whether the PWCD is authorized to access the remote database without the user of the PWCD entering a password. (App. Br. 25-26) We do not agree.

Similar to the discussion of claims 1 and 16 *supra*, Rezvani teaches this limitation by teaching both access to a remote database using a wireless communication device and use of the ESN of the wireless communication device for authentication. (FF 3-5) By teaching that each time a call is placed, the "ESN serves as the authentication token to gain access to the network" (FF 3), Rezvani teaches granting access without requiring the user of the PWCD to enter a password. Rezvani does not teach or suggest using any additional security measures beyond the ESN in order to conduct the authentication or to access the database. Thus, Rezvani suggests authenticating, without the user of the PWCD entering a password, whether the PWCD is authorized to access the remote database.

Accordingly, we conclude that Appellant has not shown that the Examiner erred in rejecting claim 32 under 35 U.S.C. § 103(a).

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-6, 12-17, and 19-32 for obviousness under 35 U.S.C. § 103.

DECISION

The rejection of claims 1-6, 12-17, and 19-32 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

rvb

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